REMARKS

The Office Action of December 26, 2008 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Summary

Turning now, to the office action, the Examiner has withdrawn the prior rejections and has indicated Applicants' argument to be moot in view of the new grounds for rejection in this non-final action. Presently, claims 1-13, 15 and 17-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Herron (US Publication Number 2005/0157921; "Herron") in view of Tagami et al. (US Patent Number 5,237,425; "Tagami"). And, claims 14 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Herron in view of Tagami, and in further in view of Draaisma (US Publication Number 2003/0227638; "Draaisma").

Rejections under 35 USC §103(a) respectfully traversed

Claims 1-13, 15 and 17-19 were rejected under 35 USC §103(a) as being obvious in view of Herron and Tagami. Considering, first, independent claim 1, Applicants respectfully submit that the rejection fails to set forth a *prima facie* case of obviousness by teaching all the limitations recited in claim 1.

In setting forth the rejection of claim 1, the Examiner relied upon alleged teachings of Tagami. In particular, the Examiner now alleges that Tagami teaches determining a rendering characteristic, as set forth as the third and fourth elements of claim 1. Applicants respectfully disagree and urge that this position by the Examiner is contrary to that previously asserted by the Examiner. In particular, in the Office Action dated June 24, 2008, at page 3, the Examiner stated,

> Tagami'425 fails to show a method determining, from the two-color input data, a rendering characteristic for each of the primary color and the secondary color; based upon the rendering characteristics, and the primary and secondary colors, representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output; and processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space.

Accordingly, on its face, the current rejection fails to establish *prima facie* obviousness as the Examiner has acknowledged that Herron (Current Action, p. 3) and Tagami (June '08 Action, p. 3) both fail to teach the limitation. Whether considered alone or in combination, the Examiner has admitted on the record that the patents presented as the basis for the rejection fail to teach all of the limitations set forth in independent claim 1. Hence the rejection is traversed, and claim 1 is respectfully urged to be in condition for allowance. Withdrawal and immediate indication of allowance, in view of this third non-final rejection, is respectfully requested.

Regarding independent claim 6, the Examiner acknowledges at p. 6 of the instant Office Action that Herron fails to specifically show the latter limitations set forth in claims 6, including "determining, for each color of the two-color input data, an equivalent color defined in a full color space by applying a first function to each color of the two-color input data; determining, from the two-color input data, a screen characteristic for the primary color and the secondary color; determining which screen characteristic is of a lesser value, and then determining if the lesser value is equal to zero; if the lesser value screen characteristic is zero, generating an intermediate output that is a function of only one of the primary and secondary colors, otherwise, generating an intermediate output that is a function of both the primary and secondary colors, wherein the intermediate outputs include a highlight color, a highlight color percentage and a black percentage; and processing the intermediate output using a second function to generate the output data representing a single color defined in at least three color space."

The rejection of claim 6 also relies upon alleged teachings of Tagami, and now alleges that Tagami teaches the limitations that the Examiner acknowledged as not being set forth by Herron. Applicants respectfully disagree, however, and urge that this position by the Examiner is contrary to that previously stated by the Examiner. In particular, in the Office Action dated June 24, 2008, at page 6, the Examiner stated,

> Tagami'425 fails to show a method determining, from the two-color input data, generating an intermediate output that is a function of both the primary and secondary colors, wherein the intermediate output include a highlight color, a highlight color percentage and a black color percentage; and processing the intermediate output using a second function to generate the output data representing a single color defined in at least threes color space.

Accordingly, on its face, the rejection of independent claim 6 also fails to establish *prima facie* obviousness as the Examiner has acknowledged that Herron (Current Action, p. 6) and Tagami (June '08 Action, p. 6), alone or in combination, fail to teach all the limitations of the claim. Thus, either alone or in combination, the Examiner has admitted that the patents relied upon fail to teach all of the limitations and the rejection is traversed. Claim 6 is respectfully urged to be in condition for allowance. Withdrawal and immediate indication of allowance is respectfully requested.

Considering independent claim 15, Applicants respectfully incorporate the arguments in traversal of the rejections as set forth above relative to independent claims 1 and 6, which are believed to similarly characterize the failure of any alleged combination of Herron and Tagami to teach the limitations set forth. In light of the admissions by the Examiner that Herron and Tagami fail to teach limitations such as "determining, for each color of the two-color input data, an equivalent color defined in a full color space by applying a first function to each color of the two-color input data" and "if the lesser screen characteristic is zero, generating an intermediate output that is a function of only one of the primary and secondary colors, otherwise, generating an intermediate output that is a function of both the primary and secondary colors, wherein the intermediate outputs include a highlight color, a highlight color percentage and a black percentage," among others, Applicants urge that *prima facie*

obviousness has not been established for independent claim 15. Claim 15 is respectfully urged to be in condition for allowance and a timely indication thereof is requested.

As for dependent claims 2-5, 7-13 and 17-19, these claims all depend from now presumably allowable amended claims 1, 6 or 15, and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to the independent claims. For purposes of brevity specific arguments of patentability are not presented herein but are respectfully reserved for a subsequent response or on appeal.

Rejection of claims 14 and 16 traversed as being incomplete or previously overcome

Regarding dependent claims 14 and 16, the rejection is, on its face, incomplete as the Examiner appears to have merely copied a prior rejection that has no basis set forth in the instant Office Action. The claims are alleged to be rejected based upon Herron, Tagami and Draaisma, yet the detailed discussion is related to Tagami, Yoshida and Draaisma. Just what is the actual basis for rejection of claims 14 and 16? As for any rejection based upon Herron and Tagami, the arguments above are respectfully asserted by Applicants as establishing the failures of Herron and Tagami to teach the recited limitations. As for any rejection based upon Tagami and Yoshida, the arguments in Applicants' prior response(s) are respectfully incorporated as having previously overcome the same rejection. Accordingly, the rejection is respectfully traversed as being incomplete or moot. An indication of allowance of claims 14 or 16 is respectfully requested.

In light of this third, non-final Office Action, Applicants respectfully request that a timely indication of allowance of all pending claims be provided, or that in the event a further non-final rejection is considered, that both the Examiner and Supervisor Poon thoroughly review the rejections – particularly in view of the Examiner's prior statements. Moreover, the Examiner is respectfully requested to provide a complete examination of the claims on the merits.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees

should be charged to USPTO Deposit Account No. No. 24-0037 for Xerox Corporation.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

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